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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,746	02/21/2006	Hiroshi Taki	427972000700	9542
25227 7590 07/12/2007 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102			EXAMINER CHEN, VIVIAN	
			ART UNIT 1773	PAPER NUMBER
			MAIL DATE 07/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/568,746	TAKI ET AL.	
	Examiner	Art Unit	
	Vivian Chen	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-10 is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over:
JAPANESE PATENT APPLICATION 63-267550 (JP '550),
in view of Applicant's Admissions,
and in view of ULLMANN'S ENCYCLOPEDIA OF INDUSTRIAL CHEMISTRY
(ULLMANN'S).

JP '550 discloses a high transparency coated polyester film, wherein the coating is formed by an aqueous coating composition contains a sulfonated copolyester containing 0.5-15 mol% sulfonate group and comprises a zirconium compound (e.g., zirconium acetate) in typical ratios of copolyester to zirconium compound of 100,000/5 to 100,000/50,000, wherein the solvent for the aqueous coating composition is water with minor amounts of water-soluble organic solvent compounds. (entire translated document, see pages 6-7)

Applicant admits that for the purposes of the invention, the term "aqueous" refers to not only water per se, but also to mixtures of water and minor amounts of water-soluble organic solvents. (Applicant's specification, lines 6-10, page 10; lines 9-15, page 13).

ULLMANN'S discloses that it is well known to apply coatings to polyester films by in-line coating (i.e., the coating is applied prior to a film orientation step). (ULLMANN'S, section 2.4.2)

It would have been obvious for one of ordinary skill in the art at the time the invention was made to use conventional coating methods to apply the coatings in JP '550 in order to obtain

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films with improved handling properties. Regarding claim 1, the method of forming the coating layer is a product-by-process limitation and is not further limiting in as so far as the structure of the product is concerned. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. ***The patentability of a product does not depend on its method of production.*** If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a ***unobvious*** difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993). See MPEP 2113. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the product is unpatentable even though the prior product was made by a different process. The patentability of a product is based on the product itself, and is not dependent on its method of production.

Response to Arguments

1. Applicant's arguments filed 4/23/2007 with respect to YANO have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's arguments filed 4/23/2007 have been fully considered but they are not persuasive.

(A) Applicant argues that the use of the claim language “consisting essentially of” limits the claimed coating composition to only two components. However, it is the Examiner’s position that the phrase “aqueous coating composition . . . consisting essentially of . . .” by necessity limits the claimed coating composition to not just two, but three components: (1) the polyester; (2) the titanium or zirconium compound; and (3) an aqueous-type solvent. Since Applicant’s own specification makes it clear that the term “aqueous” refers not only to straight water, but also refers to mixtures of predominately water and water-soluble organic solvents (Applicant’s specification, lines 6-10, page 10; lines 9-15, page 13), it is the Examiner’s position that the claim limitation of a “aqueous coating composition . . . consisting essentially of . . .” permits the presence of minor amounts of water-soluble organic solvents, such as those present in the aqueous coating compositions disclosed in JP ‘550.

Allowable Subject Matter

1. Claims 5-10 are allowable over the prior art of record.
2. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
3. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to disclose a coated biaxially oriented polyester film wherein the coating layer is formed from an aqueous coating composition consisting essentially of an

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aqueous polyester (i.e., a water-soluble or water-dispersible polyester as defined in page 10 of Applicant's specification) and the recited titanium or zirconium compound, wherein: (1) the recited hard coat layer is present on the polyester coating layer (claim 5); or (2) the aqueous polyester has the recited Tg (claim 4).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 30, 2006



Vivian Chen
Primary Examiner
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